



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,800	11/20/2003	Gary M. Klinefelter	F12.12-0127	8584

7590 02/01/2005  
Brian D. Kaul  
Westman, Champlin & Kelly  
Suite 1600  
900 Second Avenue South  
Minneapolis, MN 55402-3319

EXAMINER

COLILLA, DANIEL JAMES

ART UNIT PAPER NUMBER

2854

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/717,800

Applicant(s)

KLINEFELTER ET AL.

Examiner

Daniel J. Colilla

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-41 is/are rejected.
- 7) ☒ Claim(s) 19 and 42-45 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20031120, 20040920</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claims 10 and 15 are objected to because of the following informalities:

In claim 6, "the sheet of card substrate material" has no proper antecedent basis in the claims.

In claim 9, line 11, "a card member" appears to be a double recitation of that which has already been recited in step b).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2854

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 6-7, 9, 13, 14, 15-18, 20-21, 24-25, 27, 31, 33, 35 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Inagaki et al. (US 5,532,724).

With respect to claim 1, Inagaki et al. discloses a method of forming an ink-receptive card substrate including the steps of providing an ink-receptive material with a backing layer 101 and an ink-receptive coating 101a (Inagaki, col. 10, lines 60-62), providing a card member 112 and laminating the ink-receptive material to a surface of the card member 112 (Inagaki, col. 14, lines 23-27).

With respect to claims 2 and 20, Inagaki et al. discloses applying heat with a thermal head 114 during lamination (Inagaki et al., col. 13, lines 16-24). Since the thermal head 114 contacts the card, there must be at least some pressure applied to the card from the head 114.

With respect to claims 3 and 21, the ink-receptive material overhangs the edges of the card member 112 as shown in Figure 18 of Inagaki et al. below the rollers 107b and 107c.

With respect to claims 6 and 24, the ink-receptive material is in the form of an ink receptive film 101, 101a.

With respect to claims 9 and 27, the card member 112 is a sheet of card substrate material.

With respect to claim 13, Inagaki et al. teaches printing an image on the ink-receptive coating (col. 10, lines 37-44). It is noted that applicant has not recited any steps in the body of the claim that are particular to an identification card.

With respect to claims 14 and 18, Figure 18 of Inagaki et al. shows the backing layer 101 being wound onto a reel 103 after it has been removed from the ink-receptive coating 101a.

With respect to claim 15, Inagaki et al. (US 5,532,724) discloses a method of forming a card including the steps of providing an ink-receptive material with a backing layer 101 and an ink-receptive coating 101a (Inagaki, col. 10, lines 60-62), providing a card member 112 and printing an image on the ink-receptive coating (col. 10, lines 37-44). It is noted that applicant has not recited any steps in the body of the claim that are particular to an identification card. Inagaki further discloses laminating the ink-receptive material to a surface of the card member 112 (Inagaki, col. 14, lines 23-27).

With respect to claim 17, the orientation of an image appears to be a subjective. While Inagaki et al. makes no mention of a reverse image, it can be seen from Figure 18 that an image printed from the side that the ink is applied, will be viewed in a reverse orientation in the final card.

With respect to claim 31, Inagaki et al. discloses a device including a supply of ink-receptive material with a backing layer 101 and an ink receptive coating 101a (Inagaki, col. 10, lines 60-62), a laminating section 113,114 configured to laminate the ink-receptive material 101,101a to a surface of a card member 112 as shown in Figure 18 of Inagaki et al.

With respect to claim 33, the ink receptive material 101,101a is an elongated ink-receptive sheet.

Art Unit: 2854

With respect to claims 7, 25 and 35, the supply of ink-receptive material is an ink-receptive film contained on a supply roll 102.

With respect to claim 40, Figure 18 shows a printhead 111 which receives the ink-receptive material for printing on the ink-receptive coating 101a.

5. Claims 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Ando et al. (JP 9-300675).

With respect to claim 31, Ando et al. (JP 9-300675) discloses a device for forming a card substrate including a supply of ink-receptive material 16,17 which includes a backing layer 16 and an ink-receptive coating 17 as shown in Figure 3 of Ando et al. Further disclosed is a laminating section 9 as shown in Figures 3-6 of Ando et al.

With respect to claim 32, laminating section 9 is a heated roller (see paragraph [0030] of the English translation of Ando et al).

With respect to claim 33, the supply of ink receptive material 16,17 forms one ink-receptive sheet.

6. Claims 1, 4-5, 15 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Vaidya et al. (US 2002/0012773).

With respect to claim 1, Vaidya et al. discloses a method of forming an ink-receptive card substrate including the steps of providing an ink-receptive material including a backing layer 1 and an ink receptive coating 10 as shown in Figure 1(A) of Vaidya et al. In paragraph [0065] Vaidya et al. discloses that the final substrate 6 may be a plastic identification card as shown in

Art Unit: 2854

Figure 1(B). The ink receptive material is laminated to the card member 6 as shown in Figure 1(B) and 1(C).

With respect to claims 4 and 22, Vaidya et al. discloses that the ink-receptive material is in the form of an individual sheet (paragraph [0023] in reference to carrier substrate 1 which contains receptive layer 10).

With respect to claims 5 and 23, the sheet 1,10 completely covers the surface of the card substrate 6 shown in Figure 1(B) of Vaidya et al.

With respect to claim 15, Vaidya et al. discloses a method of forming an identification card including the steps of providing an ink-receptive material including a backing layer 1 and an ink receptive coating 10 as shown in Figure 1(A) of Vaidya et al. The coating 10 includes layer 3 which receives ink (in the form of image 5) from a printer (paragraph [0044]). In paragraph [0065] Vaidya et al. discloses that the final substrate 6 may be a plastic identification card as shown in Figure 1(B). The ink receptive material is laminated to the card member 6 as shown in Figure 1(B) and 1(C).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8, 26 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (US 5,532,724).

Art Unit: 2854

With respect to claims 8, 26 and 38, Inagaki et al. disclose the claimed method for forming an ink-receptive card substrate except that they do not disclose the dimensions of the card. However, in col. 2, lines 57-62, Inagaki et al. discloses that booklet 5 can be a passport. In Figure 2 of Inagaki et al. the passport is shown next to the card 6. This card is about the size of an identification card. It would have been obvious to make the card a standardized size of an identification card since standards are commonly known information that provide compatibility with other related machines or products.

9. Claims 10 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (US 5,532,724), as applied to claims 1-3, 6-7, 9, 13, 14, 15-18, 20-21, 24-25, 27, 31, 33, 35 and 40 above, and further in view of Lyszczarz (US 4,897,533).

With respect to claims 10 and 28, Inagaki et al. discloses the claimed method except for the step of cutting an individual card substrate from a sheet of card substrate material. However, Lyszczarz teaches die-cutting individual cards from a larger sheet of a plurality of cards as shown in Figure 4 of Lyszczarz (col. 4, lines 15-21). It would have been obvious to combine the teaching of Lyszczarz with the method disclosed by Inagaki et al. for the advantage of creating multiple cards in one set of steps rather than repeating separate groups of steps for each individual card.

10. Claims 11-12 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (US 5,532,724) as applied to claims 1-3, 6-7, 9, 13, 14, 15-18, 20-21, 24-25, 27, 31, 33, 35 and 40 above, and further in view of Conner et al. (2004/0135241).



Art Unit: 2854

With respect to claims 11 and 29, Inagaki et al. discloses the claimed method of forming an ink-receptive card substrate except for the chip with exposed contacts embedded in the card. However, Conner et al. teaches a card 1 including a chip 6 with exposed contacts 2 as mentioned in paragraph [0022] of Conner et al. It would have been obvious to combine the teaching of Conner et al. with the method of forming an ink-receptive card substrate as disclosed by Inagaki et al. for the advantage of being able to store information about the owner of the card in the card.

With respect to claims 12 and 30, Conner et al. discloses in paragraph [0024] that the card is a laminated structure. For the chip in the card to be functional it would require that the contacts be exposed without being laminated over.

11. Claims 31, 33, 34, 37, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashiba et al. (JP 2002307874) in view of Vaidya (US 2002/0012773).

With respect to claim 31, Hashiba et al. discloses the claimed device except for the backing layer of the ink-receptive material. Hashiba et al. discloses a supply 54 of ink-receptive material 55 and a laminating section 57 configured to laminate the ink-receptive material 55 to a surface of a card member 53 as shown in Figure 7 of Hashiba et al. In paragraph [0069] of the English translation Hashiba et al. discloses that the lamination sheet (ink receptive material) has an ink absorbing layer on one side. Vaidya et al. teaches a method of forming a card which includes an ink-receptive material 10 which has an ink absorptive layer 2 and a backing layer 1 as taught in paragraph [0030] of Vaidya et al. It would have been obvious to combine the teaching of Vaidya et al. with the device

Art Unit: 2854

disclosed by Hashiba et al. for the advantage of the absorptive layer 2 which facilitates drying of the ink (Hashiba et al., paragraph [0033], lines 1-2).

With respect to claim 33, the supply 54 of ink receptive material holds a plurality of sheets 55 as shown in Figure 7 of Hashiba et al.

With respect to claim 34, Hashiba et al. discloses a sheet feed mechanism represented by small circles in Figure 7 of Hashiba et al. which transport individual ink-receptive sheets 55 to the laminating section 57.

With respect to claim 37, Hashiba et al. discloses a card supply 52 containing a plurality of card members 53 and a feed mechanism configured to transport individual card members to the laminating section as shown by the four small circles to the left of supply 52 in Figure 7 of Hashiba et al.

With respect to claim 39, in paragraph [0004] of the machine translation, Hashiba et al. discloses that the card is a sheet of identification card substrate since the card can have a photograph of a person's face.

With respect to claim 40, Hashiba et al. discloses a printhead 56 that receives an ink-receptive material 55 and prints an image on the coating of the material as shown in Figure 7 of Hashiba et al.

12. Claims 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando (JP 9-300675).

With respect to claim 35, while it is not known if the embodiment Ando et al. discloses in Figures 1-8 include a supply roll of ink-receptive film, the embodiment shown in Figure 10 of

Art Unit: 2854

Ando et al. shows an ink receptive film 21 contained on a supply roll below the reference numeral "21" in the Figure. It would have been obvious to combine the teaching of the embodiment shown in Figure 10 of Ando et al. with the embodiment shown in Figures 1-8 of Ando et al. for the advantage of a compact way of storing an elongated film.

With respect to claim 36, Ando et al. discloses a heating roller 9 as shown in Figures 3-6.

13. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (US 5,532,724) as applied to claims 1-3, 6-7, 9, 13, 14, 15-18, 20-21, 24-25, 27, 31, 33, 35 and 40 above, and further in view of Vaidya et al. (US 2002/0012773).

Inagaki et al. discloses the claimed device for forming a card substrate except for the printhead being an ink jet printhead. However, Vaidya et al. teaches a method for forming a card substrate using an ink jet printhead (Vaidya et al., see title). It would have been obvious to combine the teaching of Vaidya et al. with the device for forming a card substrate disclosed by Inagaki et al. because ink jet printing provides a flexible and economically attractive option for card printing (Vaidya et al., paragraph [0008]).

***Allowable Subject Matter***

14. Claims 19 and 42-45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2854

15. The following is a statement of reasons for the indication of allowable subject matter:

Claim 19 has been allowed primarily for the step of printing following the removing step.


Claims 42-45 have been indicated as containing allowable subject matter primarily for supply of ink-receptive material having a backing layer and an ink-receptive layer, a laminating section and a separator configured to remove the backing layer from the ink-receptive coating.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (571)272-2157. The examiner can normally be reached Mon.-Thur. between 7:30 am and 6:00 pm. Faxes regarding this application can be sent to (703)872 - 9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (571)272-2168. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 21, 2004

  
Daniel J. Colilla  
Primary Examiner  
Art Unit 2854